

**REMARKS**

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the remarks herewith, which place the application in condition for allowance.

**I. STATUS OF CLAIMS AND FORMAL MATTERS**

Claims 1-3 and 6-8 are pending. No new matter is added.

It is submitted that these claims are patentably distinct from the prior art, and that these claims are in full compliance with the requirements of 35 U.S.C. §112. The remarks made herein are not made for the purpose of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112; but rather the remarks are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

**II. 35 U.S.C. §103 REJECTION**

Claims 1-3 and 7 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,411,792 to Yukinobu et al. in view of Applicants' own disclosure; claim 6 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yukinobu in view of Applicants' own disclosure and further in view of U.S. Patent No. 5,155,005 to Sato et al.; and claim 8 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,411,792 to Yukinobu et al. in view of Applicants' own disclosure and further in view of U.S. Patent No. 5,747,152 to Oka. The rejections will be collectively addressed and are respectfully traversed. None of the references, either alone or in combination, teach, suggest or motivate a skilled artisan to practice the instantly claimed invention.

It is respectfully asserted that it is well-settled that there must be some prior art teaching which would have provided the necessary incentive or motivation for modifying the reference

teachings. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (BOPAI 1993). Further, “obvious to try” is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.” Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, **both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure.** *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

Against this background, obviousness cannot attach. The instant invention is directed to a method for transferring a transparent conductive film onto one surface of a sheet base material made of a plastic material, wherein the transparent conductive film is made of a metal oxide having a specific resistance of  $3.0 \times 10^{-4}$  ohm-cm or less when the substrate is heated to a temperature of 150°C or more.

Yukinobu does not teach or suggest such an invention. More specifically, Yukinobu fails to teach or suggest a specific resistance value of  $3.0 \times 10^{-4}$  ohm-cm or lower. Instead, Yukinobu merely purports a resistance value higher than  $3.0 \times 10^{-4}$  ohm-cm. In other words, the indium-tin oxide film of Yukinobu has a resistance value higher than the instantly claimed specific resistance of  $3.0 \times 10^{-4}$  ohm-cm when the substrate is heated to a temperature of 150°C or more. Thus, the ITO film of Yukinobu (the ITO in combination with the binder) does not render Applicants' invention unpatentable.

Applicants respectfully assert that the Examiner's reliance on any alleged disclosure by Applicants is misplaced. The portions of the specification relied upon by the Examiner—as

basis for the allegation that ITO would inherently perform as the Examiner believes—does not contain information from which an obviousness rejection can be extrapolated. The Examiner's reliance on inherency is defective. The Examiner is respectfully reminded that it is not enough to merely allege that simply because ITO may be the preferred material for the claimed conductive layer that it must "inherently" speak to the invention. Instead, there must be a disclose or suggestion that the properties of the claimed invention are necessarily present in the art for inherency to attach. According to *In re Rijckaert*, 9 F.3d 1531, 1957 (Fed. Cir. 1993), "such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection." The Federal Circuit is clear that " 'inherency...may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient [to establish inherency].' " *Continental Can Company v. Monsanto Company*, 948 F.2d 1264, 1269 (Fed. Cir. 1991), *citing to In re Oelrich*, 666 F.2d 578, 581-582 (C.C.P.A. 1981). Indeed, "before a reference can be found to disclose a feature by virtue of its inherency, one of ordinary skill in the art viewing the reference must understand that the unmentioned feature at issue is *necessarily* present in the reference." *SGS-Thomson Microelectronics, Inc. v. International Rectifier Corporation*, 31 F.3d 1177 (Fed. Cir. 1994) (emphasis in original).

Further, it is manifestly clear that the Examiner is impermissibly relying on Applicants' own disclosure for support of the obviousness rejection. As noted above, the Federal Circuit in *In re Dow* was very clear that both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not in Applicants' own disclosure.

None of the secondary documents remedy these inherent deficiencies. Sato relates to a method of producing a polychromatic colored image with clear fine patterns. Oka relates to a

transparent film comprising a transparent plastic substrate film and a hard coat layer. Neither document, however, provides the requisite teaching or suggestion that would lead a skilled artisan to practice the instantly claimed method for transferring a transparent conductive film onto one surface of a sheet base material made of a plastic material, wherein the transparent conductive film is made of a metal oxide having a specific resistance of  $3.0 \times 10^{-4}$  ohm-cm or less when the substrate is heated to a temperature of 150°C or more.

It is also well-settled that “obvious to try” is not the standard upon which an obviousness rejection should be based. *See In re Fine*. And as “obvious to try” would be the only standard that would lend the Section 103 rejections any viability, the rejection must fail as a matter of law.

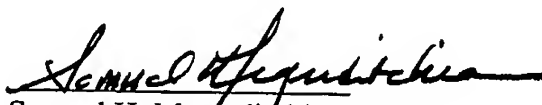
Consequently, withdrawal of the Section 103(a) rejection is believed to be in order and such action is respectfully requested.

#### CONCLUSION

By this Response, the application is in condition for allowance. Favorable reconsideration of the application, withdrawal of the rejections and prompt issuance of a Notice of Allowance are, therefore, all earnestly solicited.

Respectfully submitted,

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